

Remarks

**I. Introduction**

Claims 17-41 of the present application are pending and stand rejected under 35 U.S.C. § 101 as representing statutory type double patenting in view of claims 1-25 of U.S. Patent 6,154,544 (the '544 patent). The Applicants respectfully traverse this rejection for the reasons stated below.

**II. The § 101 Rejection is Traversed**

The appropriate standard for statutory double patenting is set forth throughout MPEP § 804. Specifically, in § 804 IIA "Statutory Double Patenting-35 U.S.C. § 101", it is stated that

"Same invention" means identical subject matter. Miller v. Eagle Mfg. Co., 151 U.S. 186 (1984); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A reliable test for double patenting under 35 U.S.C. § 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

In accordance with judicial authority and MPEP § 804 as discussed above, when a claim in the present application could be literally infringed without literally infringing a claim of the cited patent, statutory type double patenting is not shown.

The Office Action stated that "[c]laims of the instant invention use the term multi-value digit code generator and U.S. Patent 6,154,544 use[s] the term three value or trinary generator. [The] [f]unction[s] of these two generators are exactly the same which means output of multi-value digit code is exactly the same as output of three-value or trinary code." The Applicants respectfully disagree with these

assertions. More specifically, the applicants believe that it would be possible to literally infringe applicants' claims 17-41 as amended without literally infringing claims 1-25 of the '544 patent. Accordingly, the standard for evaluating statutory double patenting set forth in MPEP § 804 and discussed above has not been met.

Claims of the '544 patent literally recite the use of digits having trinary values. In digits having trinary values, each digit can assume only one of three values. In contrast, in the pending claims, multi-value digits are used and "each multi-value digit has *four or more* possible values."

In one example, a first infringer of claims 1-25 of the '544 patent must use digits having only three values to literally infringe the claims. On the other hand, a second infringer of claims 17-41 of the pending application may use, for example, digits having four, five, or six values to literally infringe these claims. It is apparent that the second infringer could not literally infringe claims 1-25 of the '544 patent (requiring three valued-digits) while still literally infringing pending claims 17-41 (requiring four or more digits). The use of four, five, or six valued digits is not literally the same as using three digits.

When pending claims 17-41 are interpreted in their plain meaning as set forth in MPEP § 2111.01, it is apparent that literal infringers of pending claims 17-41 may not be literal infringers of claims 1-25 of the '544 patent. Therefore, the Appellants respectfully traverse the rejection of claims 17-41 under 35 U.S.C. § 101.

U.S. Application No. 09/981,433  
Reply to Official Action dated April 2, 2004

**III. Conclusion**

In view of the above amendments and remarks, Applicant respectfully requests allowance of the pending claims.

The Commissioner is hereby authorized to charge any additional fees which may be required in this application under 37 C.F.R. §§1.16-1.17 during its entire pendency, or credit any overpayment, to Deposit Account No. 06-1135.

Respectfully submitted,

Fitch, Even, Tabin & Flannery



Kenneth H. Samples  
Registration No. 25,747

Date: 6/29/04

Fitch, Even, Tabin & Flannery  
120 South LaSalle Street, Suite 1600  
Chicago, Illinois 60603-3406  
Telephone: (312) 577-7000  
Facsimile: (312) 577-7007

344158